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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,465	09/05/2003	Norbert Moszner	20959/2130 (P 63013)	8449

7590 09/10/2008

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EXAMINER	
LEWIS, RALPH A	

ART UNIT	PAPER NUMBER
3732	

MAIL DATE	DELIVERY MODE
09/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/656,465	MOSZNER ET AL.	
	Examiner	Art Unit	
	Ralph A. Lewis	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19,24 and 26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19, 24 and 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/20/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Objection to the Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "flexible dental polymer film", the "detachable carrier film", the "inflatable film bag" and the "kit" with a "film" and an "adhesive" of the present claims must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 9, 11, 16, 17, 19 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornell (US 3,265,202).

Cornell discloses a flexible dental polymer film comprising a non fiber-reinforced flexible film layer which comprises polymerizable groups capable of further

polymerization, the film can be shaped around a tooth and cured by polymerization (column 1 line 16, column 1 line 37). The film contains an acrylate or methacrylate group. At least a part of the polymerizable groups is radically polymerizable. At least a part of the polymerizable groups is cationically polymerizable. The film may include an initiator (column 9 line 50), organic fillers (column 9 line 17), polymerization inhibitors (column 7 line 34), pigments (column 9 line 72), and active substance (column 9 line 35). The film is detachably held on a carrier film, the carrier film being translucent, such that it can be polyethylene.

In response to the present rejection applicant argues "the putty material according to Cornell obviously has no continuous covalent network of polymer molecules which could provide this material with any significant or structural stability. Rather, the putty material will be recognized to have free plastic formability in any direction." The examiner notes, that none of this is in the very broadly worded claims. If applicant wants such "covalent network of polymer network" limitation in the claims, then applicant should put such a limitation in the claims. Applicant's argument are much narrower than the broad claim language. Applicant further argues that such limitations are critical for the polymer film otherwise the film would have holes and breaks as it was being applied to the tooth and thus be detrimental to the film's ability to protect the tooth against caries. The examiner sees nothing in the claims about minimizing breaks or holes during application or even the film being used to protect the teeth against carries. Once again applicant is arguing subject matter that is not present in the claims.

Finally, in regard to claim 26, applicant has added a new claim 26 requiring the broadly claimed film to be "elastic" and argues that the putty sheet of Cornell "clearly is not elastic." A review of applicant's disclosure finds the now critically claimed "elastic" property briefly mentioned twice in the entire specification, the first time at page 7, line 12 where the property is set forth in a laundry list of properties that "can be varied in the desired manner" and then at page 12, line 26 where it is stated "due to its elasticity and plastic formability" it can "simply be applied to the selected area of a tooth by the user." Applicant's disclosure gives no numerical values for the elasticity of the claimed film. Moreover, applicants give no support for their statement that the Cornell putty sheet "clearly is not elastic." The examiner disputes applicant's bald assertion and is of the position that such dental paste materials do indeed have some measurable degree of elasticity (note for example Reiners et al 4,952,614 column 21, lines 10-14 disclosing the modulus of elasticity of a similar "paste"). Accordingly, in light of applicant's vague disclosure as to what is meant by the "elastic" limitation and the fact that the Cornell paste inherently has some measurable degree of elasticity, the "elastic" limitation is deemed to be fairly met by the Cornell reference.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Shimosawa et al (US 5,482,464).

Shimosawa et al disclose a flexible elastic dental polymer film 2, 3, 4 for coating a tooth 7 surface which is shaped around a tooth and cured by photopolymerization to coat the tooth (note column 3, line 62 - column 4, line 7).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (US 3,265,202) in view of Mitra et al. (US 5,154,762).

Cornell discloses a dental film that shows the limitations as described above; however, Cornell does not show the initiator in microencapsulated form. Mitra et al teach a dental polymer comprising an initiator in microencapsulated form. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the film to have microencapsulated initiator in order to enhance shelf stability in view of Mitra et al.

Claims 10, 12, 13, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (US 3,265,202) in view of Prasad et al. (US 6,039,569).

Cornell discloses a dental film that shows the limitations as described above; however, Cornell does not show the film comprising an antioxidant. Prasad et al. teach a dental film having an antioxidant (column 3 line 49). It would have been obvious to

one of ordinary skill in the art at the time the invention was made to modify the film to have a known additive such as an antioxidant in the film for enhanced antioxidant properties. Cornell shows the film having two sides, Prasad et al. teach the film having the side facing the tooth surface coated with a primer. It would have been obvious to one of ordinary skill in the art to have a coating of primer to promote adhesion of the film to the tooth surface. Prasad et al. teach a dental film and adhesive. It would have been obvious to include adhesive to the tooth surface to improve wetting and adhesion of the film to the surface.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (US 3,265,202) in view of Vallittu et al. (US 6,197,410).

Cornell discloses a dental film that shows the limitations as described above and having two sides; however, Cornell does not show the film coated with anti-adhesive additive. Vallittu et al. teach a dental film with polymeric material coating which is not adhesive in quality on the side facing away from the tooth surface. It would have been obviousto one of ordinary skill in the art at the time the invention was made to call the polymeric material of an anti-adhesive additive and to have such a coating to improve cosmetic qualities in view of Vallittu et al.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (US 3,265,202)in view of Karazivan (WO 01/93774).

Cornell discloses a dental film that shows the limitations as described above; however, Cornell does not show the carrier film of an inflatable film bag. Karazivan teaches the film detachably held on a carrier film in the form of an inflatable film bag (page 12 line 27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the film of Cornell having the carrier film of Karazivan in order to better adapt the dental film to the applied surface.

Prior Art

Applicant's information disclosure statement of August 20, 2008 has been considered and an initialed copy enclosed herewith.

Kaelble (US 4,204,325),Weissman (US 5,183,397), Yarovesky et al (US 5,624,262) and Sekiguchi et al (US 6,136,881) are made of record.

Action Made Final

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

This application has been reassigned since Examiner Bumgarner has accepted another position within the Office. Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712.** Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis
September 1, 2008

/Ralph A. Lewis/
Primary Examiner, Art Unit 3732